



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,433	11/13/2000	Jeff Stewart	424992000200	4323

23550 7590 04/04/2006

HOFFMAN WARNICK & D'ALESSANDRO, LLC  
75 STATE STREET  
14TH FL  
ALBANY, NY 12207

EXAMINER

CAMPBELL, JOSHUA D

ART UNIT PAPER NUMBER

2178

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/709,433	<b>Applicant(s)</b> STEWART ET AL.	
	<b>Examiner</b> Joshua D. Campbell	<b>Art Unit</b> 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: Request for continued examination 05/25/2005.

2. Claims 12-<sup>33</sup>~~33~~ are pending in this case. Claims 12, 17, 20, 24, 28, 29, and 31 are independent claims. Claims 17, 20, 24, 29, and 31 have been amended. Claims 32 and 33 have been newly added.

### *Claim Rejections - 35 USC § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 12-27 and 29-33 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (US Patent Number 6,625,234, filed on May 11, 1999).

**Regarding independent claim 12 and dependent claims 32 and 33,** Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide

configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

**Regarding dependent claim 13**, Adamske discloses a method in which a print drive is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of Adamske).

**Regarding dependent claim 14**, Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the print driver necessary is automatically selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

**Regarding dependent claim 15**, Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske).

**Regarding dependent claim 16**, Adamske discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 5, line 64-column 7, line 56 of Adamske).

**Regarding independent claim 17**, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies is printed in accordance with a plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet and shipping label (memo) is customized for each address and recipient is printed; at point all parts are delivered to the delivery addresses (column 7, lines 16-56 of Adamske). Adamske does not disclose that the customized

memo is obtained from the client. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to create the custom memo on the client rather than the server because it would have provided the user with the ability to create the memo with the same application as the document itself.

**Regarding dependent claim 18,** Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske also discloses a method in which a user interface is generated that may be web based (on the server) (column 5, line 64-column 7, line 15 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 5, line 64-column 7, line 56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske also discloses a method in which styles and printing options for the document are obtained and shown via the preview, which is then provided to the client (column 7, lines 16-56 of Adamske).

**Regarding dependent claim 19,** Adamske discloses a method in which a print drive is installed on the client in order to generate the print file (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a print driver is installed on the client and a print file is generated using the print driver, at which point the print file is uploaded to the server (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which the print driver necessary is automatically

selected (column 5, line 64-column 7, line 15 of Adamske). Adamske does not disclose a method in which the print driver is listed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed to have listed the print driver of Adamske because it would have allowed the user to see the format type the print file would be in.

**Regarding independent claim 20 and dependent claims 21-23**, the claims incorporate substantially similar subject matter as claims 12-15. Thus, the claims are rejected along the same rationale as claims 12-15.

**Regarding independent claim 24**, Adamske discloses a method in which a user uses software on a client device to generate a print file based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). The user then uploads the print file to the server, this print file (PostScript) being capable of being directly printed by a printer (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske does not directly disclose in this embodiment that a preview is generated by the server and provided to the user based on the print file that was uploaded. However, Adamske discloses an alternate method in which the server generates a preview based on the print file and the configuration information and provides that preview to the user for

display at the client device (column 5, line 64-column 7, line 15 of Adamske). It would have been obvious to one of ordinary skill in the art to combine the two methods of Adamske because it would have allowed the client system to do less work in the process.

**Regarding dependent claim 25**, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies is printed in accordance with a plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet and shipping label (memo) is customized for each address and recipient is printed; at point all parts are delivered to the delivery addresses provided by the client (column 7, lines 16-56 of Adamske).

**Regarding dependent claim 26**, Adamske discloses a method in which payment information is obtained for the copy and the payment is processed using that information (column 6, line 58-column 7, line 15 of Adamske).



**Regarding dependent claim 27,** Adamske discloses a method in which the print driver generates the print file and an upload manager communicates the file to the server (column 5, line 64-column 7, line 15 of Adamske).

**Regarding independent claim 29,** Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies is printed in accordance with a plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet and shipping label (memo) is customized for each address and recipient is printed; at point all parts are delivered to the delivery addresses (column 7, lines 16-56 of Adamske). Adamske does not disclose that the customized memo is obtained from the client. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to create the custom memo on the client rather than the server because it would have provided the user with the ability to create the memo with the same application as the document itself.

**Regarding dependent claim 30**, Adamske discloses a method in which the document may be generated on the client and obtained from the client (column 5, line 64-column 7, line 15 of Adamske).

**Regarding independent claim 31**, Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). A plurality of copies is printed in accordance with a plurality of addresses that are obtained from the user (column 5, line 64-column 7, line 15 of Adamske). A coversheet and shipping label (memo) is customized for each address and recipient is printed; at point all parts are delivered to the delivery addresses (column 7, lines 16-56 of Adamske). Adamske does not disclose that the customized memo is obtained from the client. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to create the custom memo on the client rather than the server because it would have provided the user with the ability to create the memo with the same application as the document itself.

5. Claim 28 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Adamske et al. (US Patent Number 6,625,234, filed on May 11, 1999) in view of Bresnan et al. (US Patent Number 5,873,073, issued on February 16, 1999 - IDS).

**Regarding dependent claim 28,** Adamske discloses a method in which a user uses software on a client device to generate a print file and uploads it to a server or a print file may be generated on a server based on a document and a print driver (column 5, line 64-column 7, line 15 of Adamske). Adamske discloses a method in which a user interface is generated that may be web based (on the server) (column 2, lines 4-60 of Adamske). The interface provides a preview section and a printing options section that allows a user to provide configuration information (i.e. style options) (column 7, lines 16-56 of Adamske). The interface is provided to the user via the Internet for display (column 2, lines 4-60 of Adamske). Adamske also discloses a method in which styles and printing options for the document are obtained and shown via the preview that may be navigated by selecting portions (navigation area), which is then provided to the client (column 5, line 64-column 7, line 56 of Adamske). Adamske does not disclose a method in which an estimate area displays an estimate of price based on the configuration and print file. However, Bresnan discloses a method in which an estimate is generated based on configuration and the file itself and presented to the user (column 14, lines 10-58 of Bresnan). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Adamske with the method of Bresnan because it would have allowed the user to see the price prior to the billing process.

### ***Response to Arguments***

6. Applicant's arguments filed 05/25/2005 have been fully considered but they are not persuasive.

Applicant's arguments on pages 9-12, regarding the independent claims and the combination of the teachings of the two embodiments of Adamske, the examiner believes that in combination the two embodiments properly teaches all of the limitations of the independent claims in question. In the first embodiment cited Adamske teaches that software used on the client can be used to generate a print file and a print preview file, the print file being forwarded to the server (column 6, lines 24-42 of Adamske). The citation in column 6, lines 24-42, explicitly states, "In this alternate embodiment, client computer includes a print driver program resident on memory that is executable to convert the electronic document and provide the print preview capability *prior* to uploading to the web server," (emphasis added). The conversion performed by a print driver program performs is equal to the conversion performed on the server in the alternate embodiment, which is converting the document into a printable electronic document (e.g. PostScript) (column 5, line 64-column 6, line 23), thus clearly showing that the client embodiment has the ability to convert the document into a print file without help from the server. By definition a print driver acts as an interpreter between the operating system or application software and the particular make and model of printer you're trying to talk to, or in other words a print driver is used to place the data you are working with in condition to be understood by the printing device you are using,

or in other words interpreting the file into a file that can be directly printed by the printer. The other cited embodiment of Adamske discloses that a server may create a preview version of the document to be displayed on the client if the server has the print file and configuration information which can be obtained via the web interface (column 6, lines 12-23 and column 6, line 58-column 7, line 15 of Adamske). The combination of these teachings would have made it obvious that if you have the power to generate the print file at the client and forward it to the server, and the power to generate a preview at the server based on the configuration generated via the interface and print file at the server, that you could forward the print file as taught in the first discussed embodiment and then use the print file and the configuration to create the preview. This would have been obvious because it would reduce the processing load at the client.

When the preview is view at any point the user may make changes to the document and generate a new preview, which would include changing configuration options such as black and white or color printing which could then be incorporated into the new preview (column 6, line 58-column 7, line 15 and column 3, line 64-column 4, line 8 of Adamske).

Applicant's arguments on pages 12-13, regarding independent claim 17 and the limitation regarding a customized memo, the examiner believes that the cited art teaches the limitation, even as it is newly recited. Adamske discloses that a cover sheet and shipping label are received from the client (column 17, lines 16-56 of Adamske), and in order for the system to work, at least the shipping label would have to be tailored to each specific recipient, otherwise the document would be improperly shipped.

All of the other arguments on pages 13-17 are in reference to the topics above, thus the rationale above can be used to respond to the similar arguments.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

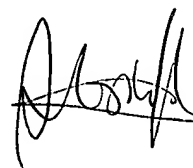
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
March 28, 2006

A handwritten signature in black ink, appearing to read 'Stephen Hong', with a stylized, cursive script.

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**